

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

In re Patent Application of

Conf. No.: 8273

RICHARDSON et al.

Atty. Ref.: JAR -3691-666

Serial No. 10/811,309

TC/A.U.: 1741

Filed: March 29, 2004

Examiner: J. LAZORCIK

For: METHOD OF MAKING COATED GLASS ARTICLE, AND
INTERMEDIATE PRODUCT USED IN SAME

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November 29, 2010

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

REPLY BRIEF

In response to the Examiner's Answer dated October 14, 2010, Applicant now
submits the following Reply Brief pursuant to 37 C.F.R. § 41.41.

This is in response to the Examiner's Answer dated October 14, 2010. The arguments set forth in Applicant's Appeal Brief are incorporated herein by reference, and Applicant will not repeat the same. The following arguments are presented in response to the new arguments presented in the Examiner's Answer (e.g., see the "Response to Arguments" section on pages 8-16 of the Examiner's Answer) -- and also further clarify Applicant's previous positions.

The Examiner's Answer includes a number of misrepresentations that require correction. For instance, page 11 states that "Although the composition of the Medwick and Konda substrates may arguably differ, Applicant will appreciate that the application of a known product (e.g. the Konda protective film) to a known substrate (e.g., the Stachowiak/Medwick low-E glass) ready for improvement in a similar manner and to a similar effect is prima facie obvious in view of the ordinary level of skill in the art at the time of the invention." Consider, for example, the following undisputed facts that are evident from a plain reading of the entireties of Medwick and Konda: Medwick and Konda are directed to (1) different types of substrates, with (2) different functional coatings disposed thereon in (3) different ways for (4) different purposes, for use in (5) different target applications. It should come as no surprise, then, that Medwick and Konda teach protective coatings that are applied and removed in completely different manners. There is no legitimate "argument" as to whether Medwick and Konda differ in any or all of these aspects: They clearly do.

Of course, the “ready for improvement” argument is both factually unsupported and unmistakably illogical. Indeed, Medwick teaches that peelable coatings applied in solid form are undesirable and should be avoided. The Examiner’s Answer now (finally) acknowledges that Medwick teaches that peelable protective coatings applied in solid form are “somewhat inferior.” But this, too, is a misrepresentation, because the whole point of Medwick is to use a liquid-applied and liquid-removable protective coating in place of a peelable protective coating. This is a clear teaching directly away from the combination that cannot be simply ignored through blind reliance on MPEP 2123. Contrary to the Examiner’s Answer, Medwick essentially does “preclude” the use of a solid protective film. Indeed, the types of modifications posited in the Examiner’s Answer would require a fundamental change to the underlying principle of operation of Medwick and/or Kondo and frustrate its entire purpose -- requirements that preclude a finding of obviousness pursuant to MPEP 2143.01 and the related case law.

There simply is no logical reason that one of ordinary skill in the art at the time of the invention would have attempted to combine a peelable coating designed for covering a 16 square inch semiconductor wafer to a 24 square foot substrate for use in an architectural window, automotive windshield, insulated glass unit, mirror, or the like.

The argument regarding “changes in size, shape, or proportion” and the citation to MPEP 2144.04 in the paragraph bridging pages 14-15 is a factually inapposite “red herring.” Applicant is not making an argument directed to the claims based on a change in size, shape, or proportion. Quite the contrary, Applicant is arguing against the

propriety of the proposed combination based on the plainly evident difference between a peelable coating applied in solid form to a 16 square inch semiconductor wafer, and a liquid-applied/liquid-removable coating for a 24 square foot glass substrate -- where the wafer and the glass also happen to be for fundamentally different applications. One skilled in the art at the time of the invention would have immediately recognized these differences and come to the conclusion that the free substitution of one for the other would be unworkable -- assuming, of course, that one were to look at the two references together in the first place. Differently stated, the only thing "predictable" to one skilled in the art at the time of the invention about trying to "scale" of Konda's coating to work with Medwick's substrate would have been that it would not have worked -- particularly because Medwick teaches that solid, peelable coatings like those provided in Konda are disadvantageous and should be avoided.

Applicant has provided a litany of surprising and unexpected advantageous results that are present in certain example embodiments of the claims. Three advantages include, for example, allowing yields to be improved by at least 50%, while also allowing significant post-HT defects to be reduced by at least 50%. Moreover, as explained in the specification at paragraph 32, it surprisingly and unexpectedly has been found that the protective layer provides added durability/protection even after it has been removed, which is believed to be related to residual material from the adhesive layer that may remain on the coating following peeling off of the protective layer. Nothing in the cited art discloses, teaches, suggests, motivates, logically compels, or in any way leads to such

advantages. In fact, Medwick teaches that residual material left on its substrate is a disadvantage that occurs when a coating like the one described in Konda is used. It is difficult to see how the Examiner's Answer could plausibly imply that these surprising and unexpected results are not worthy of any consideration.

In a nutshell, when the references are read in their entireties, it becomes clear that they would never have been combined by one skilled in the art at the time of the invention. The rejections are fatally flawed and should be reversed for at least the reasons set forth above and in Applicant's Appeal Brief.


Conclusion

The application is in clear condition for allowance, and early reversal of the Final Rejection and passage of the subject application to issue thus are earnestly solicited.

Respectfully submitted,

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